

REMARKS

Claims 7-8, 13, 19, 24-27, 35-36, 40, and 48-54 are pending. Reconsideration is respectfully requested.

Claim Status

Claims 7-8 were rejected under 35 U.S.C. § 103(a) over McClure (US 3,294,342) in view of Granzow (US 4,580,040) and Dallman (US 4,681,044).

Claim 13 was rejected under 35 U.S.C. § 103(a) over McClure in view of Granzow and Milatz (US 4,942,464).

Claims 19 and 40 were rejected under 35 U.S.C. § 103(a) over McClure in view of Granzow.

Claims 24-27 were rejected under 35 U.S.C. § 103(a) over McClure in view of Granzow and Paganini (US 4,398,257).

Claims 35-36 were rejected under 35 U.S.C. § 103(a) over Granzow in view of Dallman.

Claims 48-49 were rejected under 35 U.S.C. § 103(a) over Grosswiller (US 3,237,933 in view of Granzow and Ramachandran (US 5,483,047).

Claims 50-54 were withdrawn from consideration by the Office.

Applicants Traverse The Restriction Requirement

The Office has not shown the alleged Group (of claims 50-54) to be a distinct invention. The procedures of examining state that “The burden is on the examiner to provide reasonable examples that recite material differences” (e.g., MPEP § 806.05(e)). Applicants respectfully submit that the Examiner has not met the prerequisite criteria for insisting on restriction. Rather, the restriction requirement is based solely on mere allegation.

The Action provides no reasonable example whatsoever why claims 50-54 are drawn to a distinct invention. Nor has any criteria of distinctness based on MPEP sections § 806.05(c) to 806.05(j) been provided to Applicants, as is required for a proper restriction. The Examiner confuses distinctness with mere differences in claim scope. Thus, the restriction requirement is not legally valid.

At best, the Examiner alleges that claims 50-54 are drawn to a distinct invention *solely* based on claim 50 reciting the language of:

“a video material presenting device, wherein the video material presenting device is operative to provide video material to each respective customer display device, a video control device, wherein the video control device controls presentation of video material at each respective customer display device, wherein the video control device is operative to selectively present video material provided by the SP camera device at each respective customer display device”.

However, the record shows that the above noted claim 50 language finds support in previously recited and previously examined claims. Not only does the language find support in the pending claims, but also in appealed claims reviewed by the Board of Patent Appeals and Interferences (BPAI) with regard to their decision dated September 21, 2007.

Support in appealed claims for the noted language in pending claim 50

- a video material presenting device

“a video material presenting device” (appealed claim 15 reviewed by the BPAI);
- provide video material to each respective customer display device

“a plurality of customer stations . . . each customer station includes: a customer visual display . . . in operative connection with the SP station” (claim 40);

“a plurality of customer stations in operative connection with the SP station” (claim 24);

“each of the customer stations being in operative connection with the SP station” (claim 19);
- a video control device

“a video switching device” (claim 14);
- control presentation of video material at each respective customer display device

“video switching device is operative to selectively connect the video material presenting device to the customer visual display” (claim 15);

“video switching device is operative to selectively connect the customer visual display to either the video material presenting device or the SP CCTV camera” (claim 16);
- selectively present SP camera video at each respective customer display device

“video switching device is operative to selectively establish video connections between the SP CCTV camera and the customer video display” (claim 14):

“video switching device is operative to selectively connect the customer visual display to either the video material presenting device or the SP CCTV camera” (claim 16).

Apparently the Examiner is trying to argue lack of literal support for claim 50 wording. However, the claimed invention does not have to be described in *ipsis verbis*. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). MPEP § 2163.02 recognizes that “subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*). Additionally, “a rewording . . . where the same meaning remains intact is permissible” (MPEP § 2163.07). *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

MPEP § 803 sets forth criteria for a proper restriction. One of the criteria is that there must be a serious burden on the Examiner in order for restriction to be proper. Conversely, if the search and examination of an entire application can be made without serious burden, then it must be examined on the merits. Applicants have shown above that the Examiner has already considered the claim language on the merits. Thus, Applicants respectfully submit that the restriction is further legally improper because the criteria for serious burden has not been met.

The Restriction Requirement Is Not Timely

Applicants respectfully submit that there are time limits as to when a restriction requirement can be made. MPEP § 811 indicates that an Examiner is to “make a proper requirement as early as possible in the prosecution, in the first action if possible.” 37 C.F.R. § 1.142(a) indicates that the requirement is to “be made *before* any action on the merits” and must be made “*before* final action.” Applicants respectfully submit that the restriction requirement is not in compliance with the statutes, rules, and Office procedures. The time for requiring restriction has long expired. The record shows that this application has received numerous

Office actions on the merits for essentially the same recited subject matter. This application has also received a final rejection and a BPAI decision. Thus, the restriction requirement is further legally improper.

Even the legal community recognizes that the pending restriction requirement is legally improper. For example, note the attached published article entitled *The “Serious Burden” Requirement Has Teeth -- A Prohibition on Restriction Requirements Later in Prosecution*, Intellectual Property Today, February 2009. The article indicates that in the USPTO, an allegation of “serious burden” cannot be relied upon by an Examiner when requiring an election involving claims which were previously twice rejected. Applicants respectfully submit that such is the current situation. Again, the time for alleging restriction has long passed. Thus, because the requirement is also not timely, it is further not legally proper and should be withdrawn.

The Restriction Requirement Is Without Legal Basis

The Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being “distinct.” The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C. § 121, which expressly states that before the Patent Office may require restriction, the inventions must be both “independent” and “distinct.” The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, also expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

Before inventions can be considered to be “independent” the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. The Office has not shown that the claims directed to Applicants’ invention are unrelated in design, operation, and effect. Thus, the statutory requirements have not been met and no restriction requirement may be imposed.

The Action is absent any assertion that the sets of claims are “independent”, as is required. Thus, the Action has not shown or even asserted “independent” inventions.

Therefore, the standard used in the Action for seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The application of such an incorrect legal standard is arbitrary, capricious, and contrary to law in violation of the Administrative Procedures Act.

Arguments Against The Rejections

Claims 7-8, 13, 19, 24-27, 35-36, and 40

Applicants' prior remarks of September 21, 2009 are herein incorporated by reference. For reasons already discussed in the record, the Office has not established a *prima facie* case of obviousness. The record is absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have produced the claimed invention.

Claim 48

Grosswiller is directed to a stand alone kiosk having an opening (3) which can be accessed when a first door (70) is driven upward to allow a second door (77) to open outward.

The Office admits that the alleged support frame (9) in Grosswiller is not in an opening in an interior wall of a building. Grosswiller is absent more features than the Office admits. For example, the display device (5) alleged to be in Grosswiller is spaced above the barrier wall (2), which wall has the alleged support frame (9) mounted thereto. Thus, the alleged display device (5) (and the display device opening) is *not* supported by the alleged support frame (9).

Also, the relied upon opening (3) is not a movable user interface. Nor is the alleged display device opening (5) a part of a movable user interface (or the alleged user interface 3). Movement of a door in Grosswiller has no effect on either movement of a display device opening or movement of a carrier terminal opening.

Nor does Grosswiller teach the alleged hinge arrangement (70). The door (70) does not need a hinge because it moves vertically. For reasons of brevity, Applicants decline to list all of the many more recited features and relationships that are not taught or suggest by Grosswiller. Instead, Applicants submit that Grosswiller does not teach or suggest any of the recited features and relationships.

Granzow cannot alleviate the above noted (and admitted) deficiencies in Grosswiller. Nor would the combination of Grosswiller/Granzow have produced a customer station inside of a building, especially where the inside customer station includes a pneumatic tube carrier terminal.

Ramachandran cannot alleviate the noted (and admitted) deficiencies of Grosswiller/Granzow. The rejection alleges that a customer station (i.e., through-the-wall ATM) in Ramachandran is supported by a wall. Yet the rejection provides no evidence of record of any through-the-wall ATM being supported by a wall. Also, the document of record which is titled "1072ix Through The Wall Walk-Up Unit With ix Safe and Polymer Fascia" (File No. 177-385 Rev. 3) teaches against having a through-the-wall type of ATM supported by a wall.

Additionally, the through-the-wall ATM in Ramachandran does not include a pneumatic tube carrier terminal inside of a building. Thus, neither of Grosswiller, Granzow, nor Ramachandran teaches or suggests an inside customer station including a pneumatic tube carrier terminal. It follows that combining the references could not have produced the recited invention.

Applicants have shown that the combination of Grosswiller, Granzow, and Ramachandran does not teach or suggest the recited features. The Office has not established a *prima facie* case of obviousness. The record is absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have produced the invention of claim 48.

Claim 49

For reasons already discussed with regard to claim 48, the combination of Grosswiller, Granzow, and Ramachandran would not have produced the invention of claim 49. Furthermore, the combination also would not teach or suggest the recited "cover" features and relationships.

The Office has not established a *prima facie* case of obviousness. The record is absent a teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have produced the claimed invention.

Applicants request that the rejection of claims 19 and 40 be withdrawn

The record shows that the current 35 U.S.C. § 103(a) rejection of claims 19 and 40 based on McClure and Granzow is identical to a previously appealed rejection. That is, the 35 U.S.C. § 103(a) rejection of claims 19 and 40 based on McClure and Granzow was already fully considered by the Board of Patent Appeals and Interferences (BPAI) in Appeal No. 2007-0699. In their decision dated September 21, 2007, the BPAI reversed said rejection of claims 19 and 40. Thus, the Office is legally barred from again asserting these same rejections based on principles of *res judicata*.

The record shows that because this issue was *already* decided on by the BPAI, the 35 U.S.C. § 103(a) rejection of claims 19 and 40 based on McClure and Granzow is legally improper and should be withdrawn.

The document

The document titled "1072ix Through The Wall Walk-Up Unit With ix Safe and Polymer Fascia" (File No. 177-385 Rev. 3) was a part of the Petition filed April 14, 2008. The document was also part of Applicants' Response filed September 21, 2009. That is, the document is clearly part of the record.

The Examiner's statement that the "document has not been considered" because it "is not [in] an Information Disclosure Statement" (IDS) is without merit. Nor has the Examiner cited any legal authority to support such inaction (i.e., refusal to consider the document). The record

shows that the document was submitted as evidence regarding a patentability issue (e.g., whether the assembly 40 of Ramachandran is supported by a wall) raised in an Office action (e.g., page 4 of the Decision on Request for Rehearing dated March 15, 2008). The MPEP makes it clear that “a document [that] is submitted as evidence directed to an issue of patentability raised in an Office action . . . need *not* satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98 in order to have the examiner consider the information contained in the document” (e.g., MPEP § 609.05(c)). That is, the document (like Applicants’ current arguments) was not required to be filed in an IDS in order to be fully considered by the Examiner.

Is not an examiner supposed to determine patentability after review of all references of record? If so, then the record appears to give the impression that the Examiner is purposely avoiding admitted review of the document because it refutes the rejections.

A 37 C.F.R. § 1.132 declaration submitted herewith

The declaration is from a person with actual knowledge of the relevant art and level of ordinary skill in the art of transaction systems at the time of the present invention. The declaration further establishes that the relied upon combination of Grosswiller, Granzow, and Ramachandran does not provide any teaching/suggestion to a person of ordinary skill in the art at the time of the present invention to have produced the recited apparatus of claim 48 or claim 49.

Another 37 C.F.R. § 1.132 declaration submitted herewith

Another declaration under 37 C.F.R. § 1.132 is submitted herewith. The document of record titled "1072ix Through The Wall Walk-Up Unit With ix Safe and Polymer Fascia" (File No. 177-385 Rev. 3) infers that it was distributed by Diebold. This declaration confirms that it was distributed by Diebold.

Applicants request withdraw of the final rejection, which is premature

The Examiner's admission that the document has not been considered is an admission that not all of Applicants' previously filed arguments have been considered. Thus, the final rejection is premature.

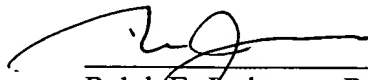
Also, there is no evidence of record that the Examiner considered the 37 C.F.R. § 1.132 declaration filed September 21, 2009. Thus, the final rejection is further premature.

In light of the evidence of record indicating that not ^{all} issues regarding patentability have been properly considered, Applicants respectfully request withdraw of the premature final rejection dated January 13, 2010.

Conclusion

Applicants respectfully submit that this application is in condition for allowance. The undersigned is willing to discuss any aspect of the Application at the Office's convenience.

Respectfully submitted,



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The "Serious Burden" Requirement Has Teeth — A Prohibition on Restriction Requirements Later in Prosecution



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BACKGROUND

For about the last decade, I have followed the strategy of appealing as soon as possible in applications for computer implemented inventions for the following reasons. First, information indicated that the policy and procedure imposed by the Director on the examining corps in this area made prosecution before the examining corps fruitless.² Second, the Board of Patent Appeals and Interferences ("BPAI") is at least nominally independent of supervision by the Director because BPAI decisions are reviewed by the Courts, not the Director. Therefore, my belief has been that a significant fraction of rejections in patent applications claiming computer implemented inventions would be reversed on appeal, leading to allowance.

Unfortunately, obtaining decisions on appeals in the computer implemented inventions area has been difficult and slow due to procedural obstacles imposed in prosecuting cases in this area. The procedural obstacles have included: examiners imposing requirements to re-file briefs to address alleged formal errors; examiners responding to appeals by reopening prosecution and imposing new grounds for rejection; and the BPAI administratively remanding cases to the examiner ordering the examiner to correct the record.³

In addition, in several cases, the examiners responded to my appeals by reopening prosecution only to the extent of imposing restriction requirements. However, the new precedent discussed below holds that requiring restriction in an application after all claims have been twice rejected is improper. Since all claims in appealed cases are normally twice rejected, the practice of responding to an appeal with a restriction requirement is generally improper and should cease.⁴ Before discussing this precedent, it is useful to summarize the conditions required for a proper restriction.

CONDITIONS REQUIRED FOR A PROPER RESTRICTION

The authority for the Director to require restriction appears in 35 USC 121, which authorizes the Director to impose a requirement for restriction whenever claimed inventions in one application are "independent and distinct."⁵ The Director specifies in the MPEP instructions to examiners. These include conditions under which examiner's may require restriction.⁶ In MPEP 803, the Director interprets 35 USC 121 to authorize restriction whenever claims in an application are independent or distinct. Various criteria are specified in the MPEP for defining inventions that are either independent or distinct from one another. The MPEP requires an examiner to specify, based upon these criteria, why the claims in an application are either independent or distinct from one another, as a necessary condition for imposing a requirement for restriction.

However, the MPEP contains an additional necessary condition that must be met by an examiner before the examiner can impose a restriction requirement. This is the requirement to show that there is a "serious burden" on the examiner to search and examine the allegedly independent or distinct claims. Specifically, the second paragraph of MPEP 803 states that:

If the search and examination of **>**all the claims in an< application can be made without serious burden, the examiner must examine **>**them< on the merits, even though **>**they include< claims to independent or distinct inventions. [MPEP 8th Edition, Rev. 5, 2006]

MPEP 803 also provides general guidance regarding what the examiner must show to satisfy the "serious burden" requirement, stating that:

For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown **>**by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § **>**806.04< - § 806.04(i) and § 808.01(a).

MPEP 808.02 also discusses the "serious burden" requirement, but its discussion is redundant of MPEP 803.

Timing is also an important factor in determining whether a requirement for restriction is proper. Respecting timing for a restriction requirement, MPEP 811 cites to 37 CFR 1.142(a). Rule 1.142(a) states that:

§ 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action. ... [Para (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

In discussing rule 1.142(a), MPEP 811 states that:

811 Time for Making Requirement [R-3]

37 CFR 1.142(a), second sentence, **>indicates that a restriction requirement "will normally< be made before any action upon the merits; however, it may be made at any time before final action **." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

The rule requirement that "however, it may be made at any time before final action" clearly indicates that a requirement for restriction is improper after a final action. However, focus on the statement "as soon as the need for a proper requirement develops". That statement indicates that a requirement for restriction should be made in response to a claim amendment resulting in claims that define "independent and distinct" inventions within the meaning of 35 USC 121. MPEP 811, first paragraph, does not expressly prohibit restriction after examination of otherwise restrictable claims. However, a question arises whether there can be a "serious burden" in examination of claims already examined. The decision discussed below addresses that question.

THERE IS NO "SERIOUS BURDEN" EXAMINING AN APPLICATION IN WHICH ALL CLAIMS WERE PREVIOUSLY TWICE REJECTED, AT LEAST IN THE EYES OF TECHNOLOGY CENTER 3600

On 3/24/2004, I filed a petition on behalf of the applicant in application 09/478,351 that requested that a restriction requirement imposed in response to the filing of an appeal brief be withdrawn and that the appeal brief be reinstated.

On 10/31/2008, the USPTO issued a decision on the petition. The decision on that petition is signed by Group Director Coggins, for Technology Center 3600. The

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decision on the petition reads in toto as follows:

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10/31/2008
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In re Application of Michael Scroggie
et al : DECISION ON PETITION
REGARDING RESTRICTION
REQUIREMENT

Applicants' petition filed on March 25, 2004 requests withdrawal of the election requirement as set forth in the Office action mailed November 24, 2003. Applicants further request reinstatement of the supplemental appeal brief filed on September 11, 2003.

The petition is GRANTED.

A review of the record reveals that the Office action mailed November 24, 2003 set forth an election requirement requiring a provisional election between five subcombinations identified as (1) Claims 28-29, 32, 73-75, 76-78, and 79-81, (2) Claims 61-62, 64, 65-72, (3) Claims 34-41, 42-44,

45-49, 82, and 83; (4) Claims 3 1, 50, 51-54; and (5) Claims 55-60 and 63. Applicants elected the subcombination of Claims 28-29, 32, 73-75, 76-78, and 79-81 with traverse in the response filed December 22, 2003. The examiner, upon reconsideration, modified the grouping of the claims and mailed a non-final office action on March 1, 2004 addressing Claims 28, 29, 32, 55-60, and 73-81. The March 25, 2004 petition was then timely filed.

Applicants' petitions [sic] allege that the election requirements are improper because there would be no burden on the examiner since all of the present claims had already been rejected at least two times prior to the election requirement.

For the foregoing reasons, the examiner's provisional election requirement has been deemed to be improper.

The application is being forwarded to the examiner for consideration of claims 28, 29, 31-32, and 34-83. An appropriate Office response to the

Appeal Brief filed on September 11, 2003 will follow in due course.

The decision holds that there is no serious burden justifying restriction when all pending claims in an application have previously been rejected at least twice. This decision is precedent indicating that prior examination of all claims at least two times immunizes the application from a requirement for restriction. There is of course nothing in the decision indicating that it is considered by the USPTO to be precedential. However, it is an agency interpretation of the agency's procedural rules. Accordingly, any subsequent petition decision to the contrary in any other case would raise issues of arbitrary and capricious agency action in violation of the administrative procedures act ("APA"). Thus, barring an official change in USPTO policy, such as a rule change, or revision in the MPEP, this decision is precedential since it would have probative evidentiary value in an APA action challenging a decision in any other case that was contrary to the holding in this case.

I raise and dispose of arguments to factually distinguish this case in the following paragraphs.

An additional fact noted in the petition and identified in the decision was that the office action imposing the restriction requirement was an office action reopening prosecution in response to the applicant's appeal. However, that fact was not relied upon in the decision; thereby indicating that the existence of an appeal is not required to immunize an application in which all claims have been rejected at least two times from restriction.

An additional fact noted in the decision is that the petition was filed in 2004, - - 4 years before the decision on the petition. In fact, what caused that delay in the USPTO included 2 administrative remand Orders from the BPAI to the examining corps to have the examining corps correct the record. However, that fact was not relied upon in the decision, thereby indicating that substantial USPTO delays are not required to immunize from restriction an application in which all claims have been rejected at least two times.

The decision also refers to an "election requirement." The MPEP distinguishes between "election" and "restriction" requirements depending upon whether the

claims are alleged to be either "independent" or "distinct". However, the "serious burden" requirement specified in the MPEP applies to all types of requirements for restriction pursuant to 35 USC 121. Accordingly, this petition decision has precedential value for applications receiving any type of requirement pursuant to 35 USC 121.

One might argue that this decision is a fluke, improvident, and does not reflect actual USPTO policy. However, I know of other petitions against restriction requirements in other cases that have been granted based upon the USPTO finding no serious burden.⁷ Thus, this decision's reliance on a finding of no serious burden is not a fluke; the fluke argument fails.

CONCLUSIONS REGARDING THE "SERIOUS BURDEN" LIMITATION ON RESTRICTION REQUIREMENTS

37 CFR 1.142(a) forbids examiners from imposing restriction requirements after examination is final. The "serious burden" requirement and 37 CFR 1.142(a) further limit the right of examiners to impose restriction requirements late in prosecution. The petition decision discussed herein above holds that examiners cannot restrict once all claims in an application have been twice rejected because there can be no "serious burden" in that situation. That petition decision is precedential to the extent that it would be probative evidence in an APA action challenging an inconsistent decision in any other application. Since all claims being twice rejected is the typical situation on appeal, the petition decision discussed herein above should curb the practice of restrictions in response to appeals. Finally, even when all claims have not been twice rejected, 37 CFR 1.142(a) and the "serious burden" requirement limit an examiner's right to impose a restriction later in prosecution.

ENDNOTES

1. I can be reached via the firm's web site: www.Neifeld.com
2. See the USPTO web page <http://www.uspto.gov/web/offices/com/strat21/action/q3p17a.htm> reporting that:

In March 2000, the USPTO established the "second pair of eyes" review for business method patents in Class 705. It is a "universal" review of all allowances in Class 705 with each allowance taking about one

hour. The purpose of this review is for the reviewer to quickly flag issues that need further consideration by the examiner and/or the examiner's supervisor.

See the Ladas and Parry law firm web page <http://www.ladas.com/BULLETINS/2006/USPTOBusinessMethodsMeeting.shtml> which notes that:

For an application in Class 705, the application allowance rate for FY2005 and at mid-year FY2006 is 19%. This compares to previous years as follows:

FY2001 45%
FY2002 26%
FY2003 16%
FY2004 11%
FY2005 19%
FY2006 at mid year 19%

The allowance rates noted on the foregoing Ladas and Parry law firm web site are well below the average allowance rates for patent applications.

3. For some data showing these difficulties, see Tables I-III in "New Rules of Practice Before the Board of Patent Appeals and Interferences - The Proposed Rules for Ex Parte Appeals, Appeals Data, and Practice Advice," Rick Neifeld, presented at the AIPLA 2008 spring meeting, and available at on my firm's publication page: <http://www.neifeld.com/advidx.html>.
4. Jurisdiction for appeal only exists once an application for patent has been twice rejected. See Ex parte Lemoine, 46 USPQ2d 1420 (BPAI 1994) (precedential decision of an expanded panel including APJ Schafer, APJ Meister, SAPJ McKelvey; CAPJ Stoner concurring on the jurisdictional issue; APJ McQuade dissenting on the jurisdictional issue). Typically, all claims in an application in which an appeal is filed have been twice rejected. It is however possible for an applicant to add new claims during prosecution that are not twice rejected before appeal.
5. 35 USC 121 states that "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." I use "restriction" in the sense used in 35 USC 121. The MPEP uses the terms "requirement for restriction" and "requirement for election of species" depending upon the relationship between the subject matter defined by the claims.
6. Many of these conditions are based upon case law antedating the 1952 patent act. For example: Ex parte Eagle, 1870 C.D. 137 (Comm'r Pat. 1870) and Ex parte Muench, 79 USQP 92, 93 (BOPA 1948) regarding restriction of species.
7. Cf. Paper titled "DECISION TO WITHDRAW RESTRICTION REQUIREMENT" dated October 20, 2008 in application 09/828,212 (Stating that "it is not deemed a significant burden on the examiner to examine the newly added Claims [because of relationship of subject matter defined by new claims to subject matter defined by old claims]...," interpolation supplied.)